

REMARKS

Upon entry of the present Response, claims 2, 4 and 8 will have been amended to correct informalities in the claim language and to more clearly define the claimed subject matter. However, Applicants submit that the amendment should not be construed as admissions to the propriety of the Examiner's rejection. Applicants respectfully submit that the amendments herein are in conformance with the originally filed disclosure and does not constitute new matter. Applicants respectfully submit that all pending claims are now in condition for allowance.

Initially, Applicants note with appreciation the Examiner's withdrawal of the previous rejection of claims 1-20. Applicants also note with appreciate the Examiner's acknowledgement of Applicant's amendments to claims 2, 4, 8, 15 and 22-23 and cancellation of claims 1 and 19-20. Applicants respectfully request correction of the acknowledgment to indicate that claim 3 was also amended. Applicants respectfully regret any inconvenience caused by claim 3 in the amendment filed on March 6, 2006 being incorrectly labeled as "Previously Presented." Claim 3 should have been labeled as "Currently Amended."

Applicants note with appreciation the Examiner's indicated allowability of the subject matter recited in claim 8, if rewritten or amended to eliminate the rejection under 35 U.S.C. §112, second paragraph, and claims 9-14, if rewritten into independent form to include all of the limitations of the base claim and any intervening claims. Applicants respectfully request correction of the indication of the objection on the cover sheet to indicate that claims 9-14 (not claims 8-14) are objected to.

In the outstanding Final Official Action mailed April 4, 2006, the Examiner rejected claim 8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner also rejected claims 5-6 under 35 U.S.C. §112, second paragraph, as being indefinite since the term "substantially" renders the claims indefinite. Further, the Examiner rejected claims 2-7, 16-18 and 21-23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,643,653 to TAKAHASHI et al.

Initially, Applicants respectfully note that the finality of the outstanding Final Official Action is improper and premature. In this regard, the Final Official Action indicates, at page 5, that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action... [a]ccordingly, **THIS ACTION IS MADE FINAL**".

However, the rejection under 35 U.S.C. §112, second paragraph with regard to claims 5-6 and 8 is a new ground of rejection that is not necessitated by applicant's amendment of the claims. As can be clearly seen by reference to the text of the original claims, each of the terms now considered to provide a basis for the rejection under 35 U.S.C. §112, second paragraph was previously present in the respective claims and thus could clearly have been previously rejected under 35 U.S.C. §112, second paragraph. However the previous Office Actions contained no rejection under 35 U.S.C. §112, second paragraph. Accordingly, finality of the rejection is premature, and the finality of the Office Action should be withdrawn. Please see MPEP §706.07(a) which states "[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not]

necessitated by applicant's amendment of the claims." Thus Applicants respectfully request withdrawal of the finality of the outstanding Official Action.

Applicants traverse the rejection of claim 8 under 35 U.S.C. §112, second paragraph. In this regard, upon entry of the present Response, Applicants will have amended claim 8 to ensure that antecedent basis is provided for the "side surface" recited therein. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. §112, second paragraph.

With regard to claims 5-6, Applicant traverse the rejection of claims 5-6 under 35 U.S.C. §112, second paragraph. The Examiner asserts that the term "substantially" is relative term which is neither defined by the claims nor provided with a standard for ascertaining the requisite degree by the specification, and thus renders the claims indefinite.

Applicants note that the terms "substantially flush" recited in claim 5 or "substantially parallel" recited in claim 6 mean that they do not require mathematical precision and exactness or strictness in the terms "flush" or "parallel." It is well known to a person of ordinary skill in the art that, in assembling endoscopes or similar optical systems, it is almost impossible to achieve a situation that is mathematically or exactly "flush" or "parallel." The term "substantially" in claims 5 and 6 means that there is a tolerance such that the disclosed functioning or operation of the device would not be impacted in assembling the endoscope according to the present invention and the scope of the claims is not limited to only a mathematically "flush" or "parallel" configuration. Further, a person of ordinary skill in the art understands the magnitude of such tolerance in assembly. Therefore, the term "substantially" has a clear and definite

meaning to such person when utilized in terms such as "substantially flush" or "substantially parallel." Accordingly, since the term "substantially" is not indefinite, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 5 and 6 under 35 U.S.C. §112, second paragraph.

With regard to independent claims 2 and 4, the Examiner asserts that TAKAHASHI et al. disclose an endoscope comprising:, a second optical system secured in the tip end of said inserting tube for observing the in vivo tissues at a second magnification that is higher than the first magnification,....., wherein a position of the first optical system is fixed in relation to a position of the second optical system within a single inserting tube.

In this regard, Applicants respectfully submit that TAKAHASHI et al. fail to teach the configuration wherein a second optical system fixed in the tip end of the inserting tube that is the same inserting tube as for a first optical system, and wherein the position of the first optical system is fixed in relation to a position of the second optical system within a single inserting tube.

TAKAHASHI et al. disclose a major endoscope 1, including objective lens 6, as a first optical system, and a minor endoscope 2, including objective lens 15, as a second optical system. However, in TAKAHASHI et al., the second optical system 15 is arranged in the end of an inserting tube 14 that is different from the tube 4 in which a first optical system 6 is arranged. In other words, in TAKAHASHI et al., there are two separate inserting tubes for the first and the second optical system. On the other hand, according to the present invention, a first optical system 810 and a second optical system 850 are fixed in the end of the same inserting tube 10. In this regard, the

Examiner's attention is respectfully directed to, for example, the language of Claim 2 which recites "an inserting tube; a first optical system secured in a tip end of said inserting tube; and a second optical system secured in a tip end of said inserting tube" (emphasis added).

In addition, in TAKAHASHI et al., a position of the first optical system is not fixed in relation to a position of the second optical system within a single inserting tube. In TAKAHASHI et al., the major endoscope has an elongated guide channel 11 which extends through the elongated tube 4 (see Fig. 6 and Col. 3, Lines 52-58). And the minor endoscope can be inserted into the guide channel 11 of the major endoscope (see Col. 4, Lines 17-28). In other words, the minor endoscope is slidably movable in the channel 11 and is not secured in the tube 4, which means that a position of the major endoscope is not fixed in relation to a position of the minor endoscope within a single inserting tube 4. Applicants note that the term "fixed" utilized in Col. 4, Line 55 in TAKAHASHI et al. indicates that the end portion 13 of the minor endoscope is fixed in the position relative to the object to be observed (see Col. 4, Lines 47-55). On the other hand, according to the present invention, a position of the first optical system is fixed in relation to a position of the second optical system within a single inserting tube. In this regard, the Examiner's attention is respectfully directed to, for example, Fig. 3 and page 15, paragraph [0058].

Since the cited prior art fails to teach or suggest the claimed subject matter of pending claims 2 and 4, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of claims 2 and 4 as being anticipated by TAKAHASHI et al.

In addition, since claims 3 and 16-18 are dependent claims depending claim 2 and claims 5-7 and 21-23 are dependent claims depending claim 4, these claims are also allowable. More so, since the present Application is in condition for allowance, Applicants respectfully further request that the Examiner allow the application to issue into a patent.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that Examiner's rejection under 35 USC §112, second paragraph and 35 USC §102(b) in the Office Action dated April 4, 2006, should be withdrawn. Further, since finality of the rejection is premature, the finality of Office Action dated April 4, 2006 should also be withdrawn. The present Response is in proper form, and none of the references teach or suggest Applicants' claimed invention. Accordingly, Applicants respectfully request timely allowance of the present application.

Applicants note that this Response is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejection is made by the present Response.

Amendment to the claim which has been made in this Response, and which has not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there by any questions regarding this paper or the present application, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Shinsuke OKADA et al.

Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

July 3, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191